

REMARKS

The subject application has been carefully considered in view of the Office Action (Final) of January 13, 2004. Accordingly, Claims 2, 4-14 and 16 have been cancelled. Claim 1 has been amended by incorporating the subject matter of cancelled Claim 5 and by further defining the size of the panels and the disposition of components (particularly the easel forming cuts) relative to the mailer panels. Claim 15 now is directed to a blank for forming the mailer/frame of Claim 1 and is amended to include the subject matter of cancelled Claim 16 together with a further description of the size and shape of the panels and the disposition of components upon folding. New dependent Claim 17 is directed to the adhesive strip that is used to adhere the frame panels together.

The cover page of the January 13, 2004, Action indicated that all pending Claims 1-9, 15 and 16 were rejected; but the body of the Action only referred to Claims 1-9 (Claims 15 and 16 were not specifically mentioned). Paragraph 4 of the Action does refer to the parallel fold lines, which are only recited in Claim 15. Accordingly, Applicant considers, for purposes of this response, that all claims (including Claims 15 and 16) stand rejected as being unpatentable over Wenkman. A call to the Examiner confirmed that this was the case.

The Drawings

The drawings are objected to as not showing the "easel forming cuts" specified in the claims. However, these cuts are shown at 26 in the as-filed Figures 1-3, 7 and 8. The amendment filed on May 23, 2003, included an amendment to pages 4 and 8 that added the reference numeral "26" to the specification. A non-final Office Action of August 11, 2003, responding to the May 23, 2003, Amendment did not raise any issue with respect to this amendment. Accordingly, no correction of the drawings appears necessary.

The Rejection and Argument

Claims 1-9 (and 15, 16) are rejected under 35 U.S.C. 103(a) as being unpatentable over Wenkman. Given the amendment to the claims as set out above, the only claims now in issue are Claims 1, 3, 15 and 17.

The reference is said to disclose the claimed elements except for the mailer rear panel connected to the mailer front panel by a fold line. The Examiner addresses the missing element (the rear mailer panel 28) by saying it would be obvious to add another panel "in order to provide more room for the user to write" and that adding such a panel represents a "mere duplication of the essential working parts...[that]... involves only routine skill in the art".

Wenkman discloses a frame and mailer having a single mailer panel that overlies the front of the picture frame. This leaves the easel cuts at the rear of the frame exposed and represent the problem with the art that the present invention addresses. Wenkman makes no reference to the possibility of adding structure to overlie the rear of the frame to protect the easel cuts. If anything, Wenkman appears to teach away from employing any structure that compromises access to the rear of the frame itself.

In this respect Wenkman first gives instructions for folding the panels to form "a pouch for receiving a picture or photograph" (see col. 7, lines 26-52). It then states "once constructed, a photograph 88 can be inserted" (col. 7, lines 52-53) and directs the reader to Figure 6 which shows the constructed mailer. Insertion of the photograph as instructed and after the Figure 6 structure is formed, requires access to the rear of the frame. Providing Wenkman with a mailer panel that overlies the rear of the frame and that has the size as set out in Applicant's Claims 1 and 15 for protecting the easel cutouts would necessarily prevent the insertion of a photograph after the pouch is formed in accordance with the procedure described by Wenkman.

Accordingly, adding a fourth panel to Wenkman having the structure and function as set out in Applicant's Claims 1 and 15 is contrary to the Wenkman disclosure and would frustrate the use of the Wenkman pouch in the manner described manner and render the Wenkman arrangement inoperative according to Wenkman's own assembly instructions.

Also, a stated object of Wenkman is to have “an inexpensive packaging device” (Col. 1, lines 53). Wenkman does this with a three panel structure so it would seem that adding another panel would add to both material and manufacturing costs in addition to preventing the insertion of a photograph per Wenkman’s instructions

There appears to be no suggestion in Wenkman for the addition of another mailer panel so that the provision of such a panel would appear to have its genesis in Applicant’s disclosure rather than in the reference itself.

To support the contention that the provision of another panel is a mere duplication of parts, the Examiner cites *St. Regis Paper Co. v Bemis co.* 193 USPQ 8 (1977). Applicant urges that the holding in the *St. Regis* case is not applicable to the present situation as the additional mailer panel as recited in Claims 1 and 15 does not constitute a mere duplication of parts for the reasons set out below.

The claim at issue in the *St. Regis* case concerned a bag having four elements, one of which was multiple plies to make it stronger. The single prior art reference, Poppe US 2,209,901, disclosed three of the four features but not the multiple plies. The Court in *St. Regis* stated at page 11 that

“While the addition of multiple plies to the concept of the Poppe bag undoubtedly made it stronger and even may have been necessary to make this type of bag commercially feasible, it is not the type of innovation for which a patent monopoly is to be granted. It is difficult to conceive of a more obvious method of strengthening a certain type of bag than putting one bag inside another.”

In the *St. Regis* case then, the “duplication of parts” was the addition of another bag ply to add to the strength offered by the existing bag ply.

In contrast to the holding in *St. Regis*, the mailer rear panel 28 as set out in Claims 1 and 15 does not comprise a duplication of any other panels. The disposition of the mailer rear panel, its location in relation to the other panels and its function in relation to the other panels clearly belies it being duplicative of any other panel including the mailer front panel. It has a different location, a different structure (in terms of how it relates to the other panels) and a different function than any other panel.

As described in the specification, the present invention includes a mailer front panel arranged to overlie (and protect) the front of the picture frame during mailing. There also is a separate mailer rear panel arranged to overlie (and protect) the rear of the frame. This is important as the rear of the frame includes easel-forming cuts which, if not protected, may become deployed during handling and mailing thereby causing problems for the Post Office (page 1, lines 20-29).

A true “duplication” of parts in the context of the St. Regis case would be a second panel having a structure and function that duplicates that of an existing panel. This clearly is not the case here. The addition of a panel at a different position for a different purpose and that is unique in its structure and function as compared to every other claimed structural component cannot constitute a duplication of parts.

Claim 1 states that each of the fold lines connecting the four panels one to another are parallel (and “sequentially arranged” in Claim 15). This disposition of the fold lines and the four panels precludes any of the panels from being duplicates of another as each panel bears a unique structural relationship to the others and each has its own function not enjoyed by any other panel.

The Examiner states that adding another mailer panel would add more writing room and that this constitutes a mere duplication of the essential parts. However, adding a duplicate writing panel to the Wenkman structure does not necessarily provide another mailing panel as claimed. For example, an extra writing panel could be foldably attached to the Wenkman three-panel structure at any number of locations that would not allow service as a mailer panel. An extra writing panel even could be of a size smaller than the claimed size (“footprint at least as large as that of the frame front and rear panels”) so as to preclude its use as a mailer panel. An extra writing panel that might be added to Wenkman, whatever its size and shape cannot be located in a position that would preclude the insertion of a photograph in the manner described by Wenkman (that is, after the pouch is made).

Thus, one wanting to add a panel to the Wenkman structure to obtain more writing space has the choice of adding it in a variety of sizes, shapes and locations

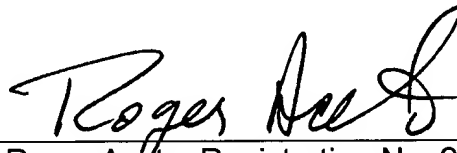
none of which would be comparable to the size, location and function of the panel as set out in Claims 1 and 15. This particularly is the case as Wenkman does not remotely suggest the possibility of doing anything either to protect the easel cutouts or to provide more writing room.

Accordingly, the limitations as set out in Claims 1 and 15 do result in a structural and functional difference that precludes the suggestion that there are duplicate parts; namely, the size and disposition of the fourth panel must be such as to permit the claimed overlaying relationship which locates the frame front and rear panels between the mailer front and rear panels and which protects the frame front panel and the easel forming cuts of the frame rear panel.

In the present invention, the addition of a mailer panel provides the incidental benefit of more writing room. In contrast, providing an additional writing panel for more writing room does not of itself provide the incidental benefit of a second mailer panel as claimed.

Accordingly, Applicant considers that the claims do patentably distinguish from Wenkman and are in condition for allowance, which action is respectfully requested

Respectfully submitted,



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